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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
SOUTHERN DIVISION**

**JAMES R. GLIDEWELL DENTAL
CERAMICS, INC.,**

Plaintiff,

vs.

KEATING DENTAL ARTS, INC.,

Defendant.

Case No.: SACV 11-1309-DOC(ANx)

**ORDER ON PLAINTIFF'S AND
DEFENDANT'S MOTIONS AND CROSS
MOTIONS FOR SUMMARY JUDGMENT**

Before the Court are several filings: (1) a Motion for Partial Summary Judgment as to Trademark Misuse, Unfair Competition, Unclean Hands, Fair Use, and Estoppel (Dkt. 79) filed by Plaintiff James R. Glidewell Dental Ceramics, Inc. ("Plaintiff"); (2) Plaintiff's Motion for Partial Summary Judgment as to Infringement of a Federally Registered Mark (Dkt.81); (3) Plaintiff's Motion for Partial Summary Judgment as to Keating Dental Arts, Inc.'s Invalidity Defense (Dkt. 82); (4) a Motion for Summary Judgment Canceling Glidewell's Trademark Registration (Dkt. 83) filed by Defendant Keating Dental Arts, Inc. ("Defendant"); and (5)

1 Defendant's Motion for Summary Judgment as to No Infringement of Glidewell's Registered
2 Trademark (Dkt. 84).

3 Oral arguments were presented to the Court on December 21, 2012. After considering all
4 the moving papers and oral arguments, the Court orders the following:

5 (1) Defendant's Motion for Summary Judgment as to No Infringement
6 (Dkt. 84) is GRANTED;

7 (2) Defendant's Motion for Summary Judgment Canceling Plaintiff's
8 Registration (Dkt. 83) is DENIED;

9 (3) Plaintiff's Motion for Summary Judgment as to Trademark Misuse,
10 Unfair Competition, Unclean Hands, Fair Use, and Estoppel (Dkt. 79) is
11 GRANTED IN PART and DENIED IN PART;

12 (4) Plaintiff's Motion for Partial Summary Judgment as to Trademark
13 Infringement (Dkt. 81) is DENIED;

14 (5) Plaintiff's Motion for Partial Summary Judgment as to Defendant's
15 Invalidity Defense and Counterclaim (Dkt. 82) is GRANTED.

16 **I. Jurisdiction**

17 The Court exercises subject matter jurisdiction over this action pursuant to 28 U.S.C. §
18 1331, 1338; and 2201; and supplemental jurisdiction over state law claims pursuant to 28 U.S.C.
19 § 1367(a). The parties do not contest personal jurisdiction.

20 **II. Background**

21 As difficult as it may be to imagine any unpleasantness associated with a trip to the
22 dentist, this case reminds us that discord and painful friction may invade even society's most
23 cheerful and unsullied icon of good times and happy memories: the dentist's chair. The parties
24 in this lawsuit are dental laboratories who, among other things, receive and fill orders for crowns
25 from dentists. In 2009, Plaintiff began marketing an all-zirconia crown under the "BruxZir"
26 trademark. In 2011, Defendant began marketing its own all-zirconia crown using the mark
27 "KDZ Bruxer" and an associated logo.

Neither party has introduced any evidence reasonably challenging the following facts: (1) “bruxism” is a well-known term of art in the dental community that describes a condition in which the dental patient grinds or gnashes her teeth, sometimes unconsciously and/or at night; (2) “bruxers” are people suffering from or experiencing bruxism; and (3) “to brux” means “to grind ones teeth.” If a bruxer has a tooth that is ground down or cracked, her dentist may prepare a dental crown. An all-zirconia crown is particularly suited for this use, since zirconia is strong enough to withstand the wear-and-tear associated with inveterate bruxing.

a. Plaintiff’s Three Causes of Action in Its Complaint

Plaintiff brings three causes of action, all based on the same alleged acts by Defendant. First, Plaintiff alleges that Defendant’s trademark, “KDZ Bruxer,” infringes Plaintiff’s federally-registered (as of January 19, 2010) trademark, “BruxZir,” under the Lanham Act, 15 U.S.C. § 1051 et seq. Compl. (Dkt. 1) at 5-6. Second, Plaintiff alleges that Defendant’s acts giving rise to the infringement claim also constitute false designation of origin within the meaning of Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a). *Id.* at 6-7. Finally, Plaintiff alleges that these acts constitute unfair competition under California Business & Professions Code 17200 et seq. *Id.* at 7-8.

b. Defendant’s Counterclaims

Defendant brings four counterclaims against Plaintiff. First, Defendant seeks a declaratory judgment of non-infringement of Plaintiff’s trademark. *See* Def’s Second Amended Answer and Counterclaims (Dkt. 67) at 14. Second, Defendant brings a claim for unfair competition under California Business & Professions Code 17200, *et seq.*, and California common law. *Id.* at 14-15. Third, Defendant brings a claim for Misuse of Trademark. *Id.* at 15-16. Fourth, Defendant makes a claim for the cancellation of Plaintiff’s trademark registration pursuant to 15 U.S.C. § 1052(e)(1). *Id.* at 17.

c. Previous Motion for Summary Judgment

Early on in this case, Defendant brought a Motion for Partial Summary Judgment as to Non-infringement (Dkt. 26) that was denied by the Court because, at the time, Defendant “failed

to meet its burden” in attempting to establish non-infringement. Order Denying Defendant's Motion for Partial Summary Judgment (Dkt. 48) at 11. However, that order made it clear that . . . the Court is not holding that the facts of this case preclude summary judgment for Defendant. The Court is merely holding that Defendant’s failure to cite to relevant law – that is, cases analyzing an infringement claim where plaintiff alleges that its composite mark is infringed by defendant’s composite mark and the marks share only a portion of letters – prevents this Court from granting summary judgment.

Id.

In denying Defendant's subsequent Motion to Reconsider (Dkt. 50), the Court elaborated:

[T]he Court will provide Defendant with another opportunity to move for summary judgment in the future. The Court provides Defendant with a second opportunity because this is a straight-forward trademark infringement case. As such, it is highly unlikely that there will be any genuine issues of material fact and it is entirely possible that Defendant could show in its second motion that it wins as a matter of law – if Defendant would just cite analogous cases finding no infringement of a plaintiff’s composite mark by a defendant’s composite mark where the marks share only a portion of letters.

May 1, 2012, Minute Order (Dkt. 52) at 1-2.

On November 19, 2012, the parties submitted their current motions and cross motions for summary judgment. Arguments were heard before the Court on December 21, 2012.

III. Legal Standard

Summary judgment is proper if “the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c). The court must view the facts and draw inferences in the manner most favorable to the non-moving party. *United States v. Diebold, Inc.*, 369 U.S. 654, 655 (1992); *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1161 (9th Cir. 1992). The moving party bears the initial burden of demonstrating the absence of a genuine issue of material fact for trial, but it need not disprove

1 the other party's case. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256 (1986); *Celotex*
 2 *Corp. v. Catrett*, 477 U.S. 317, 323-25 (1986). When the non-moving party bears the burden of
 3 proving the claim or defense, the moving party can meet its burden by pointing out that the non-
 4 moving party has failed to present any genuine issue of material fact. *Musick v. Burke*, 913 F.2d
 5 1390, 1394 (9th Cir. 1990).

6 Once the moving party meets its burden, the opposing party must set out specific facts
 7 showing a genuine issue for trial; merely relying on allegations or denials in its own pleading is
 8 insufficient. *See Anderson*, 477 U.S. at 248-49. A party cannot create a genuine issue of
 9 material fact simply by making assertions in its legal papers. *S.A. Empresa de Viacao Aerea Rio*
 10 *Grandense v. Walter Kidde & Co., Inc.*, 690 F.2d 1235, 1238 (9th Cir. 1982). Rather, there
 11 must be specific, admissible evidence identifying the basis for the dispute. *Id.* The Supreme
 12 Court has held that "[t]he mere existence of a scintilla of evidence . . . will be insufficient; there
 13 must be evidence on which the jury could reasonably find for [the opposing party]." *Anderson*,
 14 477 U.S. at 252. A court is "not required to comb the record to find some reason to deny a
 15 motion for summary judgment." *Carmen v. San Francisco Unified Sch. Dist.*, 237 F.3d 1026,
 16 1029 (9th Cir. 2001).

17 Summary judgment may be appropriate in the trademark litigation context because a
 18 likelihood of confusion between marks can be determined as a matter of law. *See Murray v.*
 19 *Cable Nat'l Broad. Co.*, 86 F.2d 858, 860 (9th Cir. 1996).

20 **IV. Discussion**

21 **a. Defendant's and Plaintiff's Motions for Summary Judgment regarding (1)** 22 **No Infringement of Plaintiff's Registered Trademark; (2) No Violation of** 23 **Section 43(a) of the Lanham Act; (3) No Unfair Competition Under** 24 **California Law**

25 Defendant has shown that Plaintiff has failed to establish at least one element of
 26 Plaintiff's first claim of trademark infringement, namely, that there is a likelihood of confusion
 27 between the parties' marks. The confusion analysis for Plaintiff's second claim of false
 28 designation of origin under Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125, is

1 the same as the analysis for infringement of a registered trademark under 15 U.S.C. § 1114. *See*
 2 *Brookfield Commc'n, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1046-47 n. 8 (9th Cir.
 3 1999) (applying same analysis to claims under Sections 1114 and 1125). Regarding Plaintiff's
 4 third claim of unfair competition, the "test" for harm under the "unfair competition [law] is
 5 exactly the same as for trademark infringement," namely, likelihood of confusion. *Century 21*
 6 *Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988). Accordingly, the Court's
 7 analysis applies to all three of Plaintiff's claims. *See New West Corp. v. NYM Co. of California,*
 8 *Inc.*, 595 F.2d 1194, 1201 (9th Cir. 1979) ("Whether we call the violation infringement, unfair
 9 competition or false designation of origin, the test is identical: is there a 'likelihood of
 10 confusion?'").

11 Regarding the test for likelihood of confusion, the Ninth Circuit considers eight
 12 "*Sleekcraft*" factors in its analysis: "[1] strength of the [plaintiff's] mark; [2] proximity of the
 13 goods; [3] similarity of the marks; [4] evidence of actual confusion; [5] marketing channels
 14 used; [6] type of goods and the degree of care likely to be exercised by the purchaser; [7]
 15 defendant's intent in selecting the mark; and [8] likelihood of expansion of the product lines."
 16 *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1145 (9th Cir. 2011)
 17 (citing *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979)); *see also* 4 McCarthy on
 18 Trademarks and Unfair Competition § 24:39 (4th ed.). However, "the list is not exhaustive,"
 19 nor is it exclusive, and "[o]ther variables may come into play depending on the particular facts
 20 presented." *Network Automation*, 638 F.3d at 1145; *see also Echo Drain v. Newsted*, 307 F.
 21 Supp. 2d 1116, 1123 (C.D. Cal. 2003) ("The presence or absence of a particular factor does not
 22 necessarily drive the determination of a likelihood of confusion."). Ultimately, the "burden of
 23 proving likelihood of confusion rests with the plaintiff." *KP Permanent Make-Up, Inc. v.*
 24 *Lasting Impression I, Inc.*, 543 U.S. 111, 122 (2004).

25 Under the "anti-dissection rule," the likelihood of confusion between two marks "is
 26 determined by viewing the trademark as a whole, as it appears in the marketplace." *Official*
 27 *Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1389, 1392 (9th Cir. 1993) (holding that district court
 28 committed "error" when it "analyzed the strength of [plaintiff's] mark by examining . . . the

term ‘Travel Planner,’ standing alone” where plaintiff alleged that its mark “OAG TRAVEL PLANNER” was infringed by defendants’ marks “THE TRAVEL PLANNER USA” and “USA TRAVEL PLANNER”); *see also China Healthways Institute, Inc. v. Wang*, 491 F.3d 1337, 1340 (Fed. Cir. 2007) (“It is incorrect to compare marks by eliminating portions thereof and then simply comparing the residue.”); 4 McCarthy on Trademarks and Unfair Competition § 23:41 (4th ed.) (“Conflicting composite marks are to be compared by looking at them as a whole, rather than breaking the marks up into their component parts for comparison.”); 15 U.S.C. § 1052(d) (referring to a whole “mark” and not portions of a mark when stating that no protection exists where “a mark . . . so resembles [another] a mark . . . as to be likely . . . to cause confusion”). The rationale behind the anti-dissection rule is that the “commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail.” *Estate of P.D. Beckwith, Inc., v. Comm’r of Patents*, 252 U.S. 538, 545-46 (1920).

The Court considers each *Sleekcraft* factor in turn.

i. Strength of Plaintiff’s Mark

Trademarks are classified by courts “along a spectrum of increasing distinctiveness: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful.” *Instant Media, Inc. v. Microsoft Corp.*, 2007 WL 2318948 at *12 (N.D. Cal. Aug. 13, 2007) (internal quotations omitted). Here, Defendant claims that Plaintiff’s mark is either generic or descriptive, and Plaintiff claims that it is suggestive. Neither claims that the “BruxZir” mark is arbitrary or fanciful.

A descriptive mark “specifically describes a characteristic or ingredient of an article or service (*i.e.*, “Park ‘N Fly”),” while a suggestive mark “suggests, rather than describes, an ingredient, quality or characteristic (*i.e.*, *Sleekcraft*).” *Id.* A suggestive mark is one for which ““a consumer must use imagination or any type of multistage reasoning to understand the mark’s significance ... the mark does not describe the product’s features, but suggests them.”” *Zobmondo Entm’t, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1114 (9th Cir. 2010) (quoting *Kendall-Jackson Winery, Ltd. v. E.&J. Gallo Winery*, 150 F.3d 1042, 1047 n.8 (9th Cir. 1998)).

1 *see also* 2 McCarthy § 11:72 (listing marks that have been found "suggestive," including
 2 "CITIBANK" for an urban bank, "CLASSIC COLA" for a soft drink, "DIAL-A-MATTRESS"
 3 for mattress sales, and "FLORIDA TAN" for suntan lotion).

4 The Court finds that "BruxZir" is suggestive, not descriptive, because it suggests, but
 5 falls short of explicitly describing, Plaintiff's zirconia crown product. It is a zirconia product
 6 made for bruxers, or tooth-grinders, but "a mental leap is required" to understand that the
 7 product is a dental crown. *See Zobmondo Entm't.*, 602 F.3d at 1116. The mark does not contain
 8 any unequivocally descriptive term, like "crown" or "cap," but rather combines the prefix "brux-"
 9 ", from "bruxer" or "bruxism," with the prefix "zir-", from "zirconia."¹ This is similar to other
 10 composite marks that have been found suggestive by other courts. *See, e.g., Survivor Media,*
 11 *Inc. v. Survivor Prods.*, 406 F.3d 625,632 (9th Cir. 2005) ("Survivor" was held to be
 12 suggestive because imagination was required to associate it with beach-related goods.); *Network*
 13 *Automation, Inc. v. Advanced Sys. Concepts*, 638 F.3d 1137, 1150 (9th Cir. 2011)
 14 ("ActiveBatch" was held suggestive because of the mental leap required to understand the
 15 product, which was scheduling software); *Brookfield Commun., Inc. v. W. Coast Entm't Corp.*,
 16 174 F.3d 1036, 1058 (9th Cir. 1999) ("MovieBuff" was suggestive in the context of computer
 17 software for researching movies through a database).

18 The Ninth Circuit has "recognized that, unlike arbitrary or fanciful marks which are
 19 typically strong, suggestive marks are presumptively weak." *Brookfield Communications*, 174
 20 F.3d at 1058 (citing *Nutri/Sys., Inc. v. Con-Stan Indus., Inc.*, 809 F.2d 601, 605 (9th Cir. 1987)).
 21 Like the court in *Nutri/Sys., Inc.*, this Court determines that Plaintiff's suggestive mark
 22 "BruxZir" is weak, since it is a composite that includes two commonly-used terms describing,
 23 respectively, the general malady the product is intended to treat and the material used to
 24 manufacture it. *See Nutri/Sys., Inc.*, 809 F.2d at 605 (affirming the district court's determination

¹ The composite also contains a phonetic double meaning, since "BruxZir" may be pronounced similarly to (or exactly the same as) "bruxer," but when the mark is viewed as written it suggests that the product is made out of zirconia.

1 that the plaintiff's mark was weak in part because "those in the food and health products field
 2 commonly use 'Nutri-' as a prefix"). A suggestive mark will receive protection "if the
 3 infringing mark is quite similar and the goods or services they connote are closely related." *Id.*
 4 (citing *Sleekcraft*, 599 F.2d at 350).

5 **ii. Similarity of the Marks**

6 The Court finds that Defendant's mark is not "quite similar" to Plaintiff's mark—it is
 7 substantially different. The district court considers the marks and names "as a whole, in their
 8 entirety, and as they appear in the market place." *Alpha Industries, Inc. v. Alpha Steel Tube &*
 9 *Shapes, Inc.*, 616 F.2d 440, 445 (9th Cir. 1980). Relevant characteristics include appearance,
 10 sound, and meaning when determining similarity. *Sleekcraft*, 599 F.2d at 351.

11 Regarding appearance, Plaintiff argues that, because they share the common four-letter
 12 sequence "Brux", the marks "BruxZir" and "KDZ Bruxer" appear very similar. Defendant
 13 argues that the marks as they appear in advertisements and in the marketplace look drastically
 14 different. Defendant emphasizes that, in the official logo associated with "KDZ Bruxer," the
 15 letters "KDZ" are many times larger than the smaller word "Bruxer," and the entire phrase is
 16 surrounded by a distinctive oval. *See* Def's Mem. in Support of Motion for Summary Judgment
 17 (Dkt. 86) at 17. BruxZir, in contrast, appears without any similar oval, and the capitalized "Z"
 18 in "BruxZir" overlaps and appears in the foreground in front of "Brux," with all the letters
 19 approximately the same size. *Id.* In addition, Defendant's "KDZ Bruxer" sometimes appears in
 20 the context of other "KDZ"-branded products ("KDZ Max" and "KDZ Ultra"), also surrounded
 21 by the distinctive oval, and also displaying an oversized "KDZ" followed by a relatively small
 22 second word, which share no common origins or similarities with BruxZir. *See id.* at 7, 17.

23 The Court finds that, to the eye, the appearance of the logos and the words "KDZ Bruxer"
 24 and "BruxZir" are not similar, and are in fact substantially distinct. In the context of logos, there
 25 is almost no visual similarity between the marks. While the Court recognizes that significant
 26 trade name uses exist that do not involve stylized logo versions of the parties' respective marks,
 27 as in written communications, newspaper typeface, or simple-text advertisements, the Court
 28 finds that the marks look substantially different above and beyond the graphic and context-

1 related differences of the parties' logos. Defendant's mark begins with an all-caps three-letter
 2 phrase, "KDZ," which is entirely absent from Plaintiff's mark, and the composite mark ends
 3 with the letters "xer," whereas Plaintiff's mark ends with "Zir." *See Alpha Industries*, 616 F.2d
 4 at 444 (where appellant used the word "Alpha" alone and in a distinctive logo, appellee's use of
 5 the word "Alpha" in conjunction with another word or words was considered dissimilar).

6 Sound is also an important factor in a similarity analysis "because reputation is often
 7 conveyed by word of mouth." *Nutri/Sys., Inc. v. Con-Stan Indus., Inc.*, 1985 WL 72061 (C.D.
 8 Cal. Sept. 30, 1985) *aff'd*, 809 F.2d 601 (9th Cir. 1987) (citing *Sleekcraft*, 599 F.2d at 351).
 9 Here, while the words "bruxer" and "BruxZir" are pronounced the same or similarly,
 10 Defendant's mark begins with an entirely separate identifying series of letters that create a
 11 wholly distinct first three syllables: *kay dee zee* ("KDZ"). Nowhere in Plaintiff's mark do any
 12 of these sounds appear. Also, to the extent that Plaintiff argued at hearing that "BruxZir" is
 13 pronounced with an emphasis on the "Z," so that it sounds more like *bruck-ZEER*, Plaintiff's
 14 argument would only augment the Court's conclusion that the marks sound substantially
 15 different.

16 The Court also examines similarities of meaning. *Sleekcraft*, 599 F.2d at 352. While
 17 both marks share a component that references "bruxers," the intended user of the product, the
 18 Court must consider the meaning of each mark *as a whole*, and Defendant's mark includes the
 19 separate component "KDZ," meaning "Keating Dental Zirconia," specifically identifying for
 20 purchasers the source of the goods as Defendant Keating. *See Brockmeyer v. Hearst Corp.*, 248
 21 F. Supp. 2d 281, 296 (S.D.N.Y. 2003) (the meaning of defendant's "O" is a reference to Oprah
 22 Winfrey).

23 The fact that the commonly-used dental term "brux" is the predominant similarity
 24 between the two marks weighs against a finding of a likelihood of similarity. When the
 25 commonality between composite marks is a term that is, by itself, descriptive, courts find the
 26 likelihood of confusion reduced. *California Security Alarms v. Escobar's Security Plus Alarm*
 27 *Systems*, 1996 U.S. Dist. LEXIS 14913 (N.D. Cal. 1996) (finding the parties' marks dissimilar
 28 where the commonality, "Security," describes the parties' services); *Alchemy II, Inc. v. Yes!*

1 *Entertainment Corp.*, 844 F.Supp. 560, 569 (C.D. Cal. 1994) (finding the marks “Teddy
 2 Ruxpin” and “TV Teddy” dissimilar where the commonality, “Teddy,” describes the parties’
 3 products: plush, talking teddy bears); *Boston Duck Tours, LP v. Super Duck Tours, LLC*, 531
 4 F.3d 1, 25 (1st Cir. 2008) (finding the marks “Boston Duck Tours” and “Super Duck Tours”
 5 dissimilar where the commonality, “Duck Tours” describes the parties’ services); *Am. Cyanamid*
 6 *Corp. v. Connaught Labs., Inc.*, 800 F.2d 306, 309 (2d Cir. 1986) (finding the marks HibVAX
 7 and HIB-IMUNE dissimilar where the commonality, “Hib,” describes the parties’ Haemophilus
 8 influenza type b vaccine); *Water Pik, Inc. v. Med-Systems, Inc.*, 848 F. Supp. 2d 1262, 1272
 9 (D. Col. 2012) (finding the marks SinuCleanse and SinuSense dissimilar where the
 10 commonality, “sinu,” is common in the sinus irrigation market); *Smithkline Beckman Corp. v.*
 11 *Proctor & Gamble Co.*, 591 F. Supp. 1229, 1238 (N.D.N.Y. 1984) (finding the marks
 12 ECOTRIN and ENCAPRIN dissimilar where the commonality, “RIN,” is derivative of the
 13 generic term “aspirin”); *see also* McCarthy on Trademarks and Unfair Competition, 4th Ed., §
 14 23:49 (when the common element of two trademarks is a generic term, the likelihood of
 15 confusion is reduced, as the public has come to expect that element on different products).
 16 Accordingly, this factor weights strongly in favor of Defendant.

17 **iii. Degree of Consumer Care**

18 Consumers of the parties’ competing products are dentists who install zirconia crowns in
 19 their patients’ mouths. In assessing whether there is a likelihood of confusion, courts look to the
 20 reasonably prudent purchaser exercising ordinary caution. *Sleekcraft*, 599 F.2d at 353.
 21 However, “[i]t is generally assumed that consumers with expertise or who are buying expensive
 22 products or services exercise a greater degree of care when doing so and are thus less easily
 23 confused.” *Edge Wireless, LLC v. U.S. Cellular Corp.*, 312 F. Supp. 2d 1325, 1333 (D. Or.
 24 2003) (citing *Brookfield Comm’s*, 174 F.3d at 1060). In this case, dentists are the consumers of
 25 the products at issue, and they have expertise in the area of selecting and installing dental
 26 crowns. *See Accuride Int’l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1537 (9th Cir. 1989)
 27 (holding that a consumer care analysis weighed against a finding of likelihood of confusion
 28 where purchasers were highly specialized professionals expected to exercise a high degree of

care). Furthermore, dentists are repeat purchasers who may buy dental crowns for different patients many times over a number of years, not one-time casual buyers. *See id.* In addition, while Plaintiff's "BruxZir" crowns sell for \$99, Defendant's "KDZ Bruxer" crowns sell for \$139, fully 140% of the price of Plaintiff's product. No matter whether the dentists themselves, their patients, or their patients' insurance might be covering the cost, the significant price differential and significant cost further distinguishes the products and weighs against a likelihood of confusion.

Plaintiff argues that dentists are not experts, nor are they particularly careful, when choosing between two *brands* of the same all-zirconia dental crown product. *See Schering Corp. v. Alza Corp.*, 207 U.S.P.Q. 504 (T.T.A.B. 1980) (finding that while physicians and pharmacists are knowledgeable in their fields, they are not necessarily knowledgeable as to marks, thus not immune from mistaking one mark for another); *Alfacell Corp. v. Anticancer Inc.*, 71 U.S.P.Q.2d 1301 (T.T.A.B. 2004) ("[T]here is no reason to believe that medical expertise as to pharmaceuticals will ensure that there will be no likelihood of confusion as to source or affiliation."); *KOS Pharmaceuticals, Inc. v. Andrx Corp.*, 369 F.3d 700, 716 n.13, 717 (3d Cir. 2004).

The Court disagrees with Plaintiff. While it is true that dentists, like physicians, are "not immune" from mistaking one mark for another in the abstract, in this case the only similarity between Plaintiff's mark and Defendant's mark happens to be the fact that both contain the term "brux." The particular expertise of dentists includes being familiar with the terms used to describe common dental maladies, including "brux." Accordingly, the Court finds that a "reasonably prudent" dentist can be expected to exhibit a relatively high degree of care and knowledge when purchasing dental crowns containing terms related to the particular maladies that they are designed to treat, and that this factor weighs against a likelihood of confusion between the marks.

iv. Defendant's intent in selecting the mark

1 While Plaintiff does not attempt to argue that it has presented direct evidence of
 2 deceptive intent on the part of the Defendant in selecting the mark “KDZ Bruxer,” it asserts that
 3 “[w]here an alleged infringer chooses a mark he knows to be similar to another, one can infer an
 4 intent to confuse,” *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. 2002), and
 5 argues that “Keating was aware of Glidewell’s BruxZir mark when it made the decision to begin
 6 selling competing products under the KDZ Bruxer mark.” Pl’s Mot. (Dkt. 81) at 23. Referring
 7 to a timeline that establishes that Plaintiff Glidewell’s “BruxZir” mark was registered, well-
 8 known, and well-advertised before Defendant Keating’s “KDZ Bruxer” came on the market in
 9 2011, Plaintiff argues that “substantial evidence of Keating’s intent to free-ride on Glidewell’s
 10 good will” exists. *Id.* at 24.

11 Plaintiff’s argument is not persuasive. First, because Plaintiff has failed to establish that
 12 Defendant’s KDZ Bruxer mark is similar to Plaintiff’s BruxZir mark, as discussed in Section
 13 IV(a)(ii), *supra*, and because this Court has held that the marks are substantially distinct, the
 14 *Smith* inference of bad intent is not available. *See Smith*, 279 F.3d at 1148 (“a mark *he knows to*
 15 *be similar to another*”) (emphasis added). The only direct evidence related to Keating’s intent
 16 shows that 1) Keating began using the “KDZ” prefix in 2006, three years prior to Plaintiff’s
 17 introduction of the BruxZir mark, Mangum Decl. Ex. 54 (Keating Dep.) at 43:15-45:12; 2) that
 18 Shaun Keating states that he expanded the “KDZ” line of products to include “KDZ Bruxer”
 19 because the all-zirconia crown would be appropriate for “bruxers,” *id.*; and 3) that Keating
 20 retained counsel to conduct a trademark search before settling on the mark “KDZ Bruxer.” *Id.*;
 21 Keating Decl. ¶ 10. Here, as in *Official Airline Guides*, even if “Defendants knew about”
 22 Plaintiff’s product, Plaintiff “failed to establish that defendants entered the field in order to
 23 deceive the public by causing confusion.” *Official Airline Guides, Inc. v. Churchfield*
 24 *Publications, Inc.*, 756 F. Supp. 1393, 1403 (D. Or. 1990), *aff’d* 6 F.3d 1385, 1394 (9th Cir.
 25 1993); *see also M2 Software, Inc. v. Madacy Entertainment*, 421 F.3d 1073, 1085 (9th Cir.
 26 2005) (evidence of defendant’s attorney conducting a trademark search and discovering
 27 plaintiff’s mark, but still believing that defendant could “carve out” a non-infringing mark,
 28 contributed to this *Sleekcraft* factor leaning towards defendant).

1 Accordingly, this factor also weighs in favor of non-infringement.

2 **v. Actual Confusion**

3 Even taking all evidence presented in the light most favorable to Plaintiff, this factor does
 4 not weigh heavily in the Plaintiff's favor. While Plaintiff argues that "the evidence of actual
 5 confusion in this case is pervasive," Pl's Opp'n (Dkt 113) at 17, the Court agrees with
 6 Defendant's contention that virtually all of Plaintiff's evidence does not support a finding of
 7 actual confusion. To the extent that actual confusion has been suggested, it is "de minimis" and
 8 "does not . . . establish a likelihood of confusion." *Official Airline Guides, Inc. v. Churchfield*
 9 *Publications, Inc.*, 756 F. Supp. 1393, 1403 (D. Or. 1990) *aff'd sub nom. Official Airline Guides,*
 10 *Inc. v. Goss*, 6 F.3d 1385 (9th Cir. 1993) (seven misdirected listing forms sent to plaintiff
 11 instead of defendant was "at best, weak" evidence of actual confusion).

12 First, Plaintiff failed to provide a consumer survey showing a likelihood of confusion,
 13 which "warrants a presumption that the results would have been unfavorable." *Playboy*
 14 *Enterprises, Inc. v. Netscape Communications Corp.*, 55 F. Supp. 2d 1070, 1084 (C.D. Cal.
 15 1999) *aff'd*, 202 F.3d 278 (9th Cir. 1999) (citing *Cairns v. Franklin Mint Co.*, 24 F.Supp.2d
 16 1013, 1041–42 (C.D. Cal.1998) ("Survey evidence is not required to establish likelihood of
 17 confusion, but it is often the most persuasive evidence. Consequently, a plaintiff's failure to
 18 conduct a consumer survey, assuming it has the financial resources to do so, may lead to an
 19 inference that the results of such a survey would be unfavorable.")). Here, Plaintiff Glidewell
 20 clearly had the financial resources to conduct a survey,² and it did not submit one.

21 Instead, in support of its claim of infringement, Plaintiff submits evidence of an incident
 22 in which an employee of Plaintiff Glidewell "randomly called" a dentist's office to offer a

² Glidewell has stated that it has an annual overall marketing budget of approximately \$8.2 million, and that it spent nearly \$3 million marketing the BruxZir brand alone from June 2009 through June 2012. See Pl's Statement of Additional Material Facts (Dkt. 114-1) at 112 (stating that \$2,957,009.07 spent on "BruxZir" represented approximately 12% of Glidewell's overall marketing budget for the three years from June 2009 through June 2012).

1 discount on BruxZir crowns, and “was asked whether the discount could apply to a previous
 2 order that had actually been submitted to Defendant for a KDZ Bruxer Crown.” Jankowski
 3 Decl. (Dkt. 91) Ex. 2 (Plaintiff’s Answers to Defendant’s Interrogatories) at 7. As the
 4 Defendant points out, the confusion in this incident appears to stem from the fact that Plaintiff’s
 5 “BruxZir” mark, when spoken over the phone to a listener who cannot see Plaintiff’s mark’s
 6 distinctive spelling, may sound identical to the word “bruxer.” Evidence that a consumer asked
 7 about the applicability of a discount to her past purchase of the phonetic equivalent of a “bruxer
 8 crown” does not establish actual confusion between Plaintiff’s and Defendant’s marks.³

9 Even assuming that the dentist may have been confused about the (aurally experienced)
 10 mark, her confusion does not suggest that “members of the buying public would *mistakenly*
 11 *purchase* [Defendant’s product] believing it was [Plaintiff’s product] or vice versa.” *Echo*
 12 *Drain v. Newsted*, 307 F.Supp.2d 1116, 1126 (C.D. Cal. 2003) (citing *Sunenblick v. Harrell*, 895
 13 F.Supp. 616, 631 (S.D.N.Y. 1995) (noting that “the relevant confusion to be avoided is that
 14 which affects purchasing decisions, not confusion generally”)); *see also Cohn v. Petsmart*, 281
 15 F.3d 837, 843 n.7 (9th Cir. 2002) (holding that “Cohn received several dozen inquiries over the
 16 years about whether the parties were related. Without some other evidence of actual confusion,
 17 however, these inquiries are too ambiguous to demonstrate actual confusion”); J. McCarthy, 3
 18 McCarthy on Trademarks and Unfair Competition § 23:16 (noting that “while enquiry evidence
 19 is admissible and relevant, standing alone with no other evidence it is insufficient to prove actual
 20 confusion”).

21 Plaintiff’s other purported evidence of actual confusion is a set of 83 prescription forms
 22 submitted by 57 different dentists to Defendant Keating that contain the word “BruxZir” (or

³ To the extent that Plaintiff attempted to introduce evidence, after the close of discovery, that appears to both contradict its earlier Interrogatory Response and contain inadmissible hearsay evidence of the Glidewell employee’s recollection of what the consumer dentist said over the phone, the Court will not consider the portions of the Fallon Declaration (Dkt. 90-1 Ex. M) that contradict timely-produced discovery documents, and the Court will not consider inadmissible hearsay.

1 “Bruxzir” or “bruxzir”), even though those dentists were ordering KZD Bruxer crowns from
 2 Defendant. While these prescription forms, standing alone, could support an inference that these
 3 dentists were confusing Defendant’s product for Plaintiff’s, Defendant has submitted
 4 declarations from thirteen of those dentists stating that they were not confused as to the source
 5 of the products that they were ordering, that they intended to order Defendant Keating’s KDZ
 6 Bruxer product, that they were preexisting Keating customers when they placed the orders, and
 7 that they used “BruxZir” or “bruxzir” generically to refer to an all-zirconia crown. *See* Def’s
 8 Reply (Dkt. 131) at 18-19 (citing declarations). Plaintiff has submitted no declarations from any
 9 dentist stating that he or she was actually confused, and has not rebutted Defendant’s showing
 10 that the prescription forms at issue do not represent instances of actual confusion as to the source
 11 of the product being ordered. *See Official Airline Guides, Inc. v. Goss*, 6 F.3d at 1393
 12 (upholding a district court’s finding of “no persuasive evidence of actual confusion” when seven
 13 of defendant’s listing forms were mailed to plaintiff but evidence suggested that senders often
 14 used listing forms in a generic manner and several “travel agents and advertisers testified that
 15 they have not confused” plaintiff’s and defendant’s marks).

16 Plaintiff suggests that, even if actual confusion has not been established, the receipts are
 17 evidence of “initial interest confusion,” wherein “the infringing mark captures initial attention
 18 from consumers who then realize that the product is different from that sold under the dominant
 19 brand but go ahead and purchase the product anyway.” Pl’s Opp’n (Dkt. 113) at 19 (citing
 20 *Brookfield Commc’ns, Inv. V. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999)).
 21 However, as discussed in the previous paragraph, Defendant has submitted voluminous evidence
 22 showing that consumers who filled out the disputed receipts were neither confused about the
 23 parties’ marks nor were they originally seeking to purchase Plaintiff’s product. Rather, they
 24 were repeat customers of Defendants who were never confused about the source of the all-
 25 zirconia crown they sought to purchase. Plaintiff has presented no evidence to refute this
 26 showing.

1 Accordingly, the Court finds that Plaintiff's evidence of actual confusion is "at best,
2 weak," and "does not establish a likelihood of confusion." *Official Airline Guides, Inc. v.*
3 *Churchfield Publications, Inc.*, 756 F. Supp. at 1403.

4 **vi. Proximity of the goods, marketing channels used, and likelihood of**
5 **expansion of the product lines.**

6 The first two factors in this section weigh in favor of the likelihood of confusion, and the
7 third is irrelevant. The goods are substantially identical (all-zirconia crowns designed for tooth-
8 grinders), the two parties use similar marketing channels to distribute their goods, and because
9 the products are already in direct competition, the Court need not consider the potential for
10 expansion into product lines that will compete in the future.

11 **vii. The *Sleekcraft* factors, taken together**

12 A consideration of all *Sleekcraft* factors, taken together, weighs strongly against a finding
13 of likelihood of confusion, due particularly to the lack of similarity between the marks.
14 Obviously, the factors named in Section IV(a)(vi) of this Order would weigh in favor of a
15 finding of likelihood of confusion for *all* similar products that compete for a similar type of
16 consumer, and yet all competing products do not involve instances of trademark infringement.

17 Taken as a whole, the dissimilarity of the marks and the weakness of Plaintiff's mark,
18 along with the expertise of the consumer base, far outweigh the similarity of the products and
19 their existence in the same marketplace. Ultimately, the *Sleekcraft* factors "are intended to
20 guide the court in assessing the basic question of likelihood of confusion," *Echo Drain v.*
21 *Newsted*, 307 F. Supp. at 1123, and here the Court finds that, making all inferences in favor of
22 the Plaintiff on the facts presented, there is no likelihood of confusion between Plaintiff's
23 "BruxZir" mark and Defendant's "KDZ Bruxer" mark.

24 Accordingly, the Court GRANTS Defendant's Motion for Summary Judgment (Dkt. 84)
25 as to 1) No Infringement of Plaintiff's Registered Trademark; (2) No Violation of Section 43(a)
26 of the Trademark Act; and (3) No Unfair Competition Under California Law. For the same
27 reasons stated above, the Court DENIES Plaintiff's Motion for Partial Summary Judgment as to
28 Trademark Infringement (Dkt. 81).

b. Plaintiff's Motion for Partial Summary Judgment as to Trademark Misuse, Unfair Competition, Unclean Hands, Fair Use, and Estoppel is Granted in Part and Denied in Part

i. Plaintiff's Motion for Partial Summary Judgment on Defendant's Third Counterclaim for Misuse of Trademark

Regarding Defendant's Third Counterclaim for Misuse of Trademark, Plaintiff argues that "no such affirmative claim exists." Pl's Mot. Regarding Trademark Misuse, etc., at 6 (citing 6 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed. 2010) § 31:44 ("Unclean hands, or trademark misuse, is purely an affirmative defense and does not form the basis for an affirmative claim for recovery."); *Juno Online Services v. Juno Lighting, Inc.*, 979 F.Supp.2d 684 (N.D. Ill. 1997); *Ford Motor Co. V. Obsolete Ford Parts, Inc.*, 318 F.Supp.2d 516, 521 (E.D. Mich. 2004) ("Plaintiff cites no case law to support its theory that trademark misuse can be an independent basis for relief. The court declines to announce or create an independent cause of action for trademark misuse and finds that Defendant's claim is more appropriately cast as a potential affirmative defense."); *Dunn Computer Corp. v. Loudcloud, Inc.*, 133 F.Supp.2d 823, 830 (E.D. Va. 2001) ("Trademark misuse is not an independent cause of action, but is, instead, only an affirmative defense to a trademark infringement claim."); *Loblaw Companies Ltd. V. Azimi*, 2001 WL 36028016 at *16 (N.D. Cal. 2001) (finding "no independent cause of action for reverse domain name hijacking," which is "a variant of the doctrine of trademark misuse"); *Santander Consumer USA Inc. v. Walsh*, 762 F.Supp.2d 217, 239 (D. Mass. 2010) (citing McCarthy and stating, "It is well settled that 'trademark misuse is purely an affirmative defense and does not form the basis for an affirmative claim for recovery.'"). *Loblaw*, the only case Plaintiff cites from within this circuit, notes that the *Juno* court "undertook an exhaustive examination of the doctrine of trademark misuse and concluded that it could not be asserted as an independent claim." 2001 WL 36028016 at *16 (citing *Juno*, 979 F.Supp.2d at 687-91).

Defendant does not persuade the Court that trademark misuse may be an independent cause of action. Defendant's strongest support for its argument is dicta in *Juno* stating that

1 “[p]erhaps a court may choose to recognize a new cause of action in a situation in which the
 2 mark holder does attempt to destroy its competitors through the use of its mark,” 979 F.Supp.2d
 3 at 690, along with a journal article allegedly urging its recognition.⁴ *See* Def’s Opp’n (Dkt. 127)
 4 (citing William E. Ridgway, *Revitalizing the Doctrine of Trademark Misuse*, 21 Berkeley Tch.
 5 L.J. 1547 (2006)). Defendant then argues that “Glidewell has been attempting to destroy
 6 competition for all-zirconia crowns” by using its trademark, its deep pockets and its legal
 7 resources to pressure smaller competitors either to abandon using descriptive terms related to
 8 “bruxers” and “bruxism” or to buy Glidewell materials and become a licensee. *See* Def’s Opp’n
 9 (Dkt. 127) at 7-9. While such facts are relevant to Defendant’s defenses against Plaintiff’s
 10 trademark infringement claims, the Court is not persuaded that a heretofore nonexistent cause of
 11 action is required to address such behavior. Here, as in *Juno*, Defendant “has adequate remedies
 12 at its disposal,” and it has failed to persuade the Court “to create a new cause of action.” *See*
 13 *Juno*, 979 F.Supp.2d at 690-91.

14 Accordingly, Plaintiff’s Motion for Partial Summary Judgment is GRANTED as to
 15 Defendant’s Third Counterclaim for Misuse of Trademark.

16 **ii. Plaintiff’s Motion for Partial Summary Judgment on Defendant’s**
 17 **Second Counterclaim for Unfair Competition Under the UCL and**
 18 **California Common Law.**

19 **1. Defendant’s Statutory Claim**

20 Plaintiff argues that Defendant Keating lacks standing to raise its Second Counterclaim
 21 for Unfair Competition under California Business & Professions Code 17200, *et seq.*, because
 22 “Keating has not suffered economic harm as a result of Glidewell’s alleged acts of unfair
 23 competition.” Pl’s Mot. Regarding Patent Misuse at 11. Plaintiff further argues that, even if

⁴ The Court agrees with Plaintiff that the Ridgway article cited by Defendant does not appear to endorse the type of trademark misuse cause of action that Defendant urges, going so far as to state that “this Article opposes the adoption of an antitrust-based doctrine of trademark misuse.” Ridgway, 21 Berkeley Tch. L.J. at 1565.

1 Defendant has standing to bring its UCL Counterclaim, that claim must fail on the merits at the
2 summary judgment stage. Pl's Mot Regarding Trademark Misuse at 12-21.

3 In order to show standing under the California UCL, a party must "(1) establish a loss or
4 deprivation of money or property sufficient to qualify as injury in fact, i.e., *economic injury*, and
5 (2) show that the economic injury was the result of, i.e., *caused by*, the unfair business practice
6 or false advertising that is the gravamen of the claim." *Kwikset Corp. v. Superior Court*, 51
7 Cal.4th 310, 322 (2011).

8 Defendant argues that it has produced evidence showing an economic injury because (1)
9 "sales stagnated and declined" for its KDZ Bruxer product after Glidewell initiated this lawsuit;
10 (2) Defendant has scaled back advertising for the KDZ Bruxer "to mitigate any liability" arising
11 from this lawsuit; and (3) Defendant has "lost business from dentists who stopped ordering
12 Keating's KDZ Bruxer product once they learned that Keating was defending a lawsuit brought
13 against it based on the KDZ Bruxer product." Def's Opp'n (Dkt. 127) at 10.

14 To the extent that each of Defendant's examples of alleged economic harm resulted from
15 Plaintiff's initiation of the present litigation, Keating's claim is barred by the litigation privilege,
16 Cal. Civ. Code § 47(b), and federal *Noerr-Pennington* doctrine, both of which preclude liability
17 for the act of filing a lawsuit. The litigation privilege imposes an "absolute bar" to liability.
18 *Rubin v. Green*, 4 Cal. 4th 1187,1201 (1993) (holding the litigation privilege barred a UCL
19 claim). It "applies to any communication (1) made in judicial or quasi-judicial proceedings; (2)
20 by litigants or other participants authorized by law; (3) to achieve the objects of the litigation;
21 and (4) that have some connection or logical relation to the action." *Silberg v. Anderson*, 50
22 Cal.3d 205, 212 (1990); *see also Action Apartment Ass'n, Inc. v. City of Santa Monica*, 41 Cal.
23 4th 1232,1249 (2007) ("We contemplate no communication that is more clearly protected by
24 the litigation privilege than the filing of a legal action."); *Kashian v. Harriman*, 98 Cal.App.4th
25 892, 917 (2002) (holding that even the "fil[ing] [of] meritless lawsuits on behalf of 'sham
26 plaintiffs'" was "essentially communicative conduct" to which the litigation privilege applied,
27 "even though it also may have involved noncommunicative acts").

1 Similarly, “[u]nder the *Noerr-Pennington* doctrine, “[t]hose who petition government for
 2 redress are generally immune from antitrust liability.” *Manistee Town Ctr. v. City of Glendale*,
 3 227 F.3d 1090, 1092 (9th Cir. 2000) (citing *Professional Real Estate Investors, Inc. v. Columbia*
 4 *Pictures Indus., Inc.*, 508 U.S. 49, 56 (1993)). Outside of antitrust statutes, *Noerr-Pennington*
 5 doctrine “stands for a generic rule of statutory construction, applicable to any statutory
 6 interpretation that could implicate the rights protected by the Petition Clause.” *Sosa v.*
 7 *DIRECTV, Inc.*, 437 F.3d 923, 931 (9th Cir. 2006) (citing *White v. Lee*, 227 F.3d 1214, 1231
 8 (9th Cir.2000) (holding that because it “is based on and implements the First Amendment right
 9 to petition,” the *Noerr-Pennington* doctrine is not limited to the antitrust context, but “applies
 10 equally in all contexts”)). In the litigation context, “not only petitions sent directly to the court
 11 in the course of litigation, but also conduct incidental to the prosecution of the suit” is protected
 12 by the *Noerr-Pennington* doctrine. *Id.* at 934 (quotations omitted); *see also MedImmune, Inc. v.*
 13 *Genentech, Inc.*, 2003 WL 25550611 (C.D. Cal. 2003) (applying *Noerr-Pennington* doctrine to a
 14 state unfair competition claim).

15 There is an exception for “sham” lawsuits, which applies when “(1) the petitioner's
 16 lawsuit is objectively baseless and (2) the baseless lawsuit conceals a subjective attempt to
 17 interfere directly with the business relationships of a competitor.” *Manistee Town Ctr.*, 227
 18 F.3d at 1094. The first prong requires that “no reasonable litigant could realistically expect
 19 success on the merits.” *Prof'l Real Estate Investors, Inc. v. Columbia Pictures Indus., Inc.*, 508
 20 U.S. 49, 60 (1993)

21 Here, because Defendant's only attempt to establish economic injury rests on the
 22 allegation that Plaintiff's lawsuit caused it to lose business, the Court finds that the litigation
 23 privilege and *Noerr-Pennington* doctrine apply. Furthermore, Defendant fails to allege, and
 24 fails to make any showing, that Plaintiff's lawsuit is a “sham” as defined by the Ninth Circuit in
 25 *Prof'l Real Estate Investors*—to the extent that Plaintiff owns a federally-registered trademark
 26 and is attempting to enforce it against a competitor with an arguably similar mark, Defendant
 27 cannot state that “no reasonable litigant” could expect success on the merits of Plaintiff's claim.

1 To the extent that Defendant asserts that other non-litigation activities of the Plaintiff are
 2 grounds for its UCL claim—activities including the cease-and-desist letter that Plaintiff sent
 3 Defendant, similar letters that Plaintiff sent to third parties, and Defendant's alleged attempt to
 4 monopolize the market for zirconia crowns—Defendant fails to present any evidence that it has
 5 suffered an economic injury as a result of any of these acts. Defendant's only proffered evidence
 6 of causation regarding any alleged economic harm is related to Plaintiff's filing the present
 7 litigation.

8 Accordingly, because Defendant lacks standing to make its statutory UCL claim,
 9 Plaintiff's Motion for Partial Summary Judgment as to Defendant's Second Counterclaim for
 10 Unfair Competition is GRANTED.

11 **2. Defendant's Common Law Claim**

12 Defendant "does not oppose the portion of [Plaintiff's] motion that seeks dismissal of
 13 [Defendant's] unfair competition claim under California common law." Def's Opp'n (Dkt. 127)
 14 at 2. Accordingly, the Court GRANTS Plaintiff's Motion for Partial Summary Judgment as to
 15 Defendant's Second Counterclaim for Unfair Competition under California common law.

16 **iii. Defendant's Affirmative Defenses**

17 The remainder of Plaintiff's Motion for Partial Summary Judgment as to Trademark
 18 Misuse, Unfair Competition, Unclean Hands, Fair Use, and Estoppel (Dkt. 79) is related to
 19 Defendant's affirmative defenses. Because the Court finds that Defendant is entitled to
 20 summary judgment on the issue of non-infringement, as discussed in Section IV(a) *supra*, and
 21 because the Court makes this decision based solely on a finding that there is no likelihood of
 22 confusion between the marks, the portions of Plaintiff's motion related to Defendant's
 23 affirmative defenses upon which this Court did not rely are DENIED AS MOOT.

24 **c. Defendant's Motion for Summary Judgment Canceling Plaintiff's** 25 **Trademark Registration and Plaintiff's Motion for Summary Judgment as** 26 **to the Mark's Validity**

27 By counterclaim and by affirmative defense, and in a lively display of pique, Defendant
 28 Keating challenges the validity of Plaintiff's federally registered "BruxZir" mark and asks this

1 Court to order that Glidewell's U.S. Trademark Registration No. 3,739,663 be canceled. *See*
 2 Def's Mem. in Support of Motion for Summary Judgment Canceling Plaintiff's Mark (Dkt. 85)
 3 at 2 (seeking summary judgment on Defendant's Fourth Counterclaim); Def's Second Am.
 4 Answer and Counterclaims (Dkt. 67) at 4 (arguing that Glidewell's BruxZir mark is "invalid
 5 and/or unenforceable" because the mark is "generic and/or descriptive").

6 Defendant acknowledges that, because "BruxZir" is a registered trademark, "a
 7 presumption of validity places the burden of proving genericness upon" the Defendant.
 8 *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.2d 974, 977 (9th Cir. 2010)(citing *Filipino*
 9 *Yellow Pages, Inc. v. Asian Journal Publs. Inc.*, 198 F.3d 1143, 1146 (9th Cir. 1999); *see also*
 10 15 U.S.C. § 1057(b) (registration is "prima facie evidence of the validity of the registered
 11 mark"); *Zobmondo Entm't, LLC v. Falls Media, LLC*, 602 F.3d 1108, 1113 (9th Cir.
 12 2010)("[F]ederal registration . . . entitles the plaintiff to a strong presumption that the mark is a
 13 protectable mark.")(internal quotations omitted). The only way for the Defendant to prevail in
 14 its counterclaim is thus to show, by a preponderance of the evidence, that Plaintiff's mark is
 15 either generic or descriptive and lacking secondary meaning. *Yellow Cab Co. of Sacramento v.*
 16 *Yellow Cab of Elk Grove, Inc.*, 419 F.3d 925, 928 (9th Cir. 2005), *Surgicenters of America, Inc.*
 17 *v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979). "The crucial date for the
 18 determination of genericness is the date on which the alleged infringer entered the market with
 19 the disputed mark or term." *Yellow Cab*, 419 F.3d at 928.

20 Here, Defendant's counterclaim for cancelation must fail because the Court has
 21 determined that Plaintiff's "BruxZir" mark is and always has been *suggestive*, not generic or
 22 descriptive. As discussed at length in Section IV(a)(i) of this Order, *supra*, the mark suggests,
 23 but falls short of describing, the product with which it is associated. A suggestive mark is
 24 "inherently distinctive and [is] automatically entitled to protection. . . ." *Yellow Cab*, 419 F.3d
 25 at 927.

26 Accordingly, the Court DENIES Defendant's Motion for Summary Judgment Canceling
 27 Plaintiff's Trademark Registration and GRANTS Plaintiff's Motion for Partial Summary
 28 Judgment as to Keating's Invalidity Defense and Counterclaim.

V. Disposition


For the foregoing reasons, the Court:

- (1) GRANTS Defendant's Motion for Summary Judgment as to No Infringement (Dkt. 84);
- (2) DENIES Defendant's Motion for Summary Judgment Canceling Plaintiff's Registration (Dkt. 83);
- (3) GRANTS IN PART AND DENIES IN PART Plaintiff's Motion for Summary Judgment as to Trademark Misuse, Unfair Competition, Unclean Hands, Fair Use, and Estoppel (Dkt. 79).
 - a. The Court GRANTS Plaintiff's Motion for Partial Summary Judgment as to Defendant's Second Counterclaim for Unfair Competition under the UCL and under California law;
 - b. The Court GRANTS Plaintiff's Motion for Partial Summary Judgment as to Defendant's Third Counterclaim for Misuse of Trademark;
 - c. The Court DENIES AS MOOT Plaintiff's Motion for Partial Summary Judgment as to the affirmative defenses of Unclean Hands, Classic Fair Use, and Estoppel;
- (4) Plaintiff's Motion for Partial Summary Judgment as to Trademark Infringement (Dkt. 81) is DENIED;
- (5) Plaintiff's Motion for Partial Summary Judgment as to Defendant's Invalidity Defense and Counterclaim (82) is GRANTED.

Accordingly, because this Order has resolved all issues set for trial, the trial on this matter is hereby REMOVED from the Court's calendar and a Judgment on the matter will be issued.

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DATED: February 21, 2013



DAVID O. CARTER
UNITED STATES DISTRICT JUDGE